

REMARKS

This is a full and timely response to the non-final Office Action dated September 8, 2003 (Paper No. 10). This paper amends allowable claims 22 to 25, 27 and 28 so as to incorporate the limitations of their base and intervening claims as requested by the examiner and further requests the reconsideration of certain findings of fact in connection with the rejection of claims 2 to 6. Claims 21 and 26 have been subsequently cancelled. Accordingly, claims 2 to 6, 17 to 20, 22 to 25, 27 and 28 are currently pending. Reexamination and reconsideration in light of the present amendment and the following remarks are respectfully requested.

Allowable Subject Matter:

The Applicant thanks the examiner for the allowance of claims 17 to 20 and for the acceptance of claims 22 to 25, 27 and 28 as containing allowable subject matter. In accordance with the examiner's suggestion, claims 22 to 25, 27 and 28 have been rewritten so as to include all of the limitations of their base and intervening claims. Accordingly, claims 22 to 25, 27 and 28 are allowable for at least the reasons set forth by the examiner on page 3 of the Office Action dated September 8, 2003 (Paper No.

10). Withdrawal of the objection to these claims is courteously solicited.

Claim Rejections - 35 U.S.C. § 102(b):

In the action, claims 2 to 6, 21 and 26 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a), as allegedly being obvious over U.S. Patent No. 5,523,609 to Fukusho ("Fukusho"). This rejection is respectfully traversed in light of the present amendment.

Independent claims 3 and 4 of the present invention recite a solid-imaging device comprising, *inter alia*, a light-shielding film formed so as to cover an electrode formed on a semiconductor substrate on regions of the semiconductor substrate other than a region above a light-receiving portion.

In contrast, the Fukusho reference fails to disclose, teach or suggest a light-shielding film formed so as to cover an electrode formed on a semiconductor substrate on regions of the semiconductor substrate other than a region above a light-receiving portion. In fact, as is clearly shown in Figures 1 and 5 of Fukusho, the multilayer light shielding 16, 17 of Fukusho is formed so as to completely cover the entire region above the light-receiving portion 10. No suggestion or teaching in the

specification or drawings of Fukusho discloses otherwise. Such a configuration, wherein the light-shielding film is formed so as to completely cover the entire region above the light-receiving portion, clearly fails to anticipate or render obvious each and every element disclosed in claims 3 and 4 of the present invention under the standards set forth by the Federal Circuit. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"). Accordingly, a *prima facie* rejection of the claims has not been established, and withdrawal thereof is respectfully requested.

Moreover, aside from the novel limitations therein, claims 2, 5 and 6, being dependant upon either independent claim 3 or 4, also represent allowable subject matter for at least the reasons set forth above. Withdrawal of the rejection of these claims is also respectfully requested.

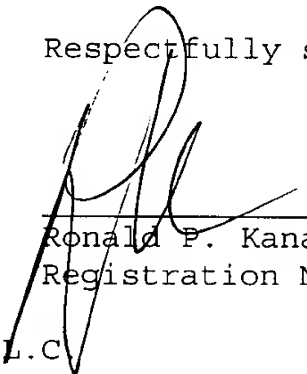
The rejection of claims 21 and 26 has been rendered moot in light of their cancellation.

Conclusion:

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Respectfully submitted,

Date: December 22, 2003



Ronald P. Kananen
Registration No. 24,104

RADER, FISHMAN AND GRAUER P.L.L.C.
The Lion Building
1233 20th Street, N.W., Suite 501
Washington, D.C. 20036
Telephone: (202) 955-3750
Facsimile: (202) 955-3751
Customer No. 23353
DC142795